

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. RYAN, JR., ROBERT K. GOTTLIEB and JOSEPH D. MALLOZZI

Appeal No. 2005-0729
Application No. 10/036,982

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)), for appropriate action with regard to the following issues.

(1) *The effective filing date of the published Call application*

In the final rejection (mailed November 6, 2003), the examiner rejected claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Lopez et al. (hereinafter Lopez)¹

¹ U.S. Patent Application Publication No. 2003/0058099, published March 27, 2003, of Application No. 10/134,941, filed April 30, 2002, which is a continuation of Application No. 09/999,462, filed October 31, 2001.

in view of Call et al. (hereinafter Call)² and, in the alternative, as being unpatentable over Lopez in view of Call, and further in view of Lohmann³ and/or Hayduchok et al. (hereinafter Hayduchok)⁴. Our review of the present application file indicates that the examiner did not cite the Provisional Application No. 60/337,674, on which the published Call application is purportedly based, and on the filing date of which the examiner relies in applying Call as prior art against the claims of the present application (answer, page 6), on a PTO-892 form or supply a copy thereof to the appellants. Moreover, the examiner failed to offer any explanation as to why the disclosure in the published Call application relied upon by the examiner was entitled to the benefit of the filing date of the provisional application.

The appellants argued on page 5 of their brief (filed May 5, 2004) that, in failing to provide a copy of Provisional Application No. 60/337,674 to support entitlement to the earlier filing date for the material in Call cited in the rejection, the examiner had failed to establish that Call is available as prior art against the appellants' claims. In response to that argument, the examiner simply stated, on page 6 of the answer (mailed August 30, 2004), that "Call is entitled to the benefit of the filing date of prior copending U.S. provisional patent application 60/337,674, filed on Nov. 13, 2001, and

² U.S. Patent Application Publication No. 2002/0124664, published September 12, 2002, of Application No. 10/066,404, filed February 1, 2002. This published application is based on prior U.S. Provisional Patent Application No. 60/337,674, filed November 13, 2001.

³ U.S. Pat. No. 6,169,936, issued January 2, 2001.

⁴ U.S. Pat. No. 6,303,889, issued October 16, 2001.

therefore qualifies as a reference.⁵ The appellants again complained, on page 3 of their reply brief (filed September 3, 2004), that the examiner did not provide a copy of the provisional application to establish such entitlement and maintain their argument that "the current record does not support the use of Call '664 as a reference in the present case."

The examiner bears the initial burden of presenting a *prima facie* case of obviousness. See Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is thus the examiner's burden, in presenting a *prima facie* case of obviousness, to establish that Call is available as prior art under 35 U.S.C. § 102(e)⁶ with respect to the claims under appeal. This the examiner has not done.

At the very least, in order to establish that Call is available as prior art with respect to the claims under appeal, the examiner must provide the appellants with a copy of the provisional application on which it is based and point out where the disclosure relied upon in the rejection is supported in the earlier provisional application. We therefore remand this application to the examiner to review the disclosure of the provisional application to determine whether the disclosure in Call relied upon in the

⁵ The examiner's failure to provide the appellants with a copy of the provisional application at issue does not appear to have been in compliance with the USPTO policy then in effect, as set forth in the December 10, 2003 and October 29, 2004 memoranda issued to the Patent Examining Corps by Stephen G. Kunin, then Deputy Commissioner for Patent Examination Policy, directed to "transitional practice of supplying a copy of a provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e) to a reference applied in a rejection."

⁶ 35 U.S.C. § 102(e) provides an exception, where the invention was described in an application for patent, published under section 122(b), by another filed in the United States before the invention thereof by the applicant for patent, to the general rule that a person is entitled to a patent .

rejection is supported therein and, if the examiner determines that such disclosure is supported in the provisional application, (1) provide the appellants with a copy of the provisional application and (2) point out, on the record, where the material in Call relied upon in rejecting the claims under appeal is found in the provisional application.

(2) The appellants' disclosure of "a filtered transition area"

One of the argued distinctions between claim 1 under appeal and the applied prior art is the limitation "a filtered transition area downstream of the diverter." As such, it would not be prudent for us to decide this case without knowing what the appellants mean by this terminology. This filtered transition area is not illustrated in detail in any of the drawings of the present application. Rather, it is simply identified with the reference numeral 43 and an arrow in Figures 5a, 6, 7a, 8a and 9a. In Figures 5a, 6, 8a and 9a, the arrow indicates that the transition area 43 is located on the detection and/or sanitization area side of the dotted line partition between the detection and/or sanitization area and clean room while, in Figure 7a, the arrow points to the clean room side of the dotted line partition. On pages 12, 16 and 19 of the present specification, the appellants describe this transition area as follows:

Appropriate filtration and sealing can be provided in transition area 43 of the feed path F that is a passage between the clean room 42 and detection room 41 [sanitization area 40]. A containment module (not shown), for example, can be placed around that area with filtration devices and an opening along the feed path F to accommodate the largest mailpiece which can be sorted by the system.

While this disclosure makes reference to “filtration” and “sealing,” no filtration or sealing is illustrated in the drawings so as to permit us to understand what area of the disclosed system is filtered or sealed or where such filters or seals are located. Consequently, we have difficulty understanding what the appellants’ disclosed “filtered transition area” is. We therefore remand this application to the examiner to consider whether the appellants’ specification provides enabling disclosure of the “filtered transition area” in compliance with the first paragraph of 35 U.S.C. § 112 and to explain how this terminology in claim 1 is being interpreted.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED



CHARLES E. FRANKFORT
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS
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) INTERFERENCES



JOHN P. MCQUADE
Administrative Patent Judge

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JENNIFER D. BAHR
Administrative Patent Judge

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